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OFFICE OF PETITIONS

In re Application of :
Young et al. :
Application No. 09/728,471 :
Filed: 30 November, 2000 :
Attorney Docket No. CITI0207 :

ON PETITION

This is a decision on the petition, styled under 37 CFR 1.47(a) and filed on 10 December, 2004, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR 1.131 in that it requires that a declaration filed thereunder by signed by all inventors.¹

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

This application was filed on 30 November, 2000, and named Alan Young, Philip Chapman, and Robert Berardy as joint inventors was filed on 16 March, 2001.

On 10 December, 2004, the present petition, along with a declaration under 37 CFR 1.131 signed by joint inventor Young, was filed.

¹ Once an application has received a fully executed oath or declaration under 37 CFR 1.63 and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. See MPEP 603.

Petitioners state that a copy of the declaration under 37 CFR 1.131 was sent to both non-signing inventors at their former work addresses, but that no response was received. Petitioners additionally state that they have been informed that the non-signing inventors no longer are employed by assignee Citibank, N.A., ("Citibank") and that their current whereabouts are unknown.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

There is no requirement for a showing under 37 CFR 1.47, as noted above. This application bears an original Declaration executed by all joint inventors, and thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

Petitioners' showing is deficient in that proof of diligent efforts to locate Chapman and Berardy have not been made.² Specifically, the last known addresses of the non-signing inventors are their work addresses at Citibank. Obviously, if Chapman and Berardy no longer work at Citibank, petitioners cannot reach them at said addresses. Moreover, petitioners have not shown what steps have been taken to determine the current addresses of the joint inventors. Petitioners may wish to consult telephone or Internet directories, *inter alia*, in an attempt to locate the non-signing inventors and send them copies of the declaration under 37 CFR 1.131.

Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts having first-hand knowledge of the details.

If a more recent address is discovered for either or both of the inventors, petitioners should send the declaration to the inventor(s) at that address. If the envelope sent to the non-signing inventor at the last known address is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application was returned as undeliverable with any renewed petition. If the inventor(s)

²MPEP 409.03(d).

refuse in writing to sign, a copy of that written refusal should be provided with any renewed petition. If the inventor refuses orally, petitioners should submit details of the refusal in an affidavit or declaration of facts by a person having first-hand knowledge of the refusal.

If repeated efforts to locate the inventor(s) and obtain the declaration under 37 CFR 1.131 are unsuccessful, petitioners will have shown that the inventor(s) cannot be located.

It is additionally noted that the fee for a petition under 37 CFR 1.183 is \$400.00, rather than \$200.00.³ As such, counsel's deposit account, No. 50-1428, will be charged the additional \$200.00 as authorized in the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703)872-9306
Attn: Office of Petitions

By hand: Customer Service Window
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Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571.272.3231.



Douglas I. Wood
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Office of Petitions

³See 37 CFR 1.17(f).